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September 21, 2015

VIA ECF

The Honorable Eric N. Vitaliano
U. S. District Court
Eastern District of New York
225 Cadman Plaza East
Brooklyn, New York 11201

Re: Travel Sentry, Inc. v. David Tropp
Case No. 06-cv-6415 ("Travel Sentry")

David Tropp v. Conair Corp. et al.
Case No. 08-cv-4446 ("Conair")

Dear Judge Vitaliano:

We submit this letter on behalf of Travel Sentry and the Defendants in the *Conair* case (collectively "Defendants"), in response to Tropp's September 16, 2015 letter to Your Honor seeking a pre-motion conference and leave to file a cross motion for summary judgment on infringement. Defendants believe that the requested conference and leave should be denied.

First, Tropp's letter does not provide any reasoning as to how or why the Federal Circuit's recent ruling in *Akamai Technologies Inc. v. Limelight Networks, Inc.*, ___ F.3d ___, 2015 U.S. App. LEXIS 14175 (Fed. Cir. Aug. 13, 2015) (en banc) in any way supports infringement in either *Travel Sentry* or *Conair*. Instead, Tropp quotes a portion of the en banc opinion and then simply concludes that the facts in *Akamai* are "extremely similar" to the facts in these cases. Accordingly, Tropp has not explained the basis for his desired motion, as required under Your Honor's Individual Motion Practice and Rules. For the same reason, nor has Tropp shown the required "good cause" for filing a summary judgment cross-motion this late in these cases.

Second, there is no basis for Tropp's contemplated motion, and leave should be denied on futility grounds. As Defendants will explain in their upcoming briefing regarding *Akamai* (due on September 25th), the Federal Circuit's slightly expanded standard in no way triggers liability here. Contrary to Tropp's conclusory assertion, the undisputed facts here are demonstrably different than the facts in *Akamai*.

At bottom, the Federal Circuit expanded the traditional direction and control standard to include only situations where a defendant conditions participation in an activity (or receipt of a benefit) upon performance of a step or steps of the method in question *and* establishes the manner or timing of that performance. When this standard is applied to the facts in *Akamai*, it appears to be custom tailored to that case, but not at all to the facts here. In *Akamai*, defendant Limelight performed all but the last step of Akamai's method patent regarding internet content delivery. The last step -- the content tagging step -- was performed by Limelight's customers. However, unlike here, Limelight's customers did not operate independently from Limelight in performing this last content tagging step. Instead, Limelight contractually required its customers to perform the tagging step *as a condition to* receiving Limelight's service, and that, through specific instructions and other direct involvement in the actual tagging, Limelight actually controlled the manner and timing of its customers' performance of the tagging step. *See Akamai*, 2015 U.S. App. LEXIS 14175 at *9-11. Limelight therefore exerted a level of direction and control over its customers' activity such that all steps were effectively performed by Limelight.

Here, in contrast, no Defendant in *Conair* in any way conditions participation in any activity (or receipt of a benefit) upon any other participant's performance of any step of Tropp's patents. As this court has previously found, none of these Defendants has any relationship with the TSA such that any of them could be shown to condition participation by the TSA in any activity (or receipt of any benefit) on performing luggage screening. Moreover, there is no fact in the record showing that any Defendant establishes the manner or timing of the TSA's luggage screening. Instead, the record shows that the TSA operates fully independently of each of the Defendants, and that it alone determines whether, when and how it performs luggage screening at commercial U.S. airports.

The same is true for Travel Sentry. While Travel Sentry does have a written Memorandum of Understanding ("MOU") with the TSA, as this court has found, that "relatively noncommittal 'understanding' between Travel Sentry and the TSA" in no way conditions participation by TSA in any activity (or receipt of any benefit) on performing luggage screening. *See Travel Sentry, Inc. v. Tropp*, 736 F. Supp. 2d 623, 638 (E.D.N.Y. 2010), *rev'd on other grounds*, 497 Fed. Appx. 958 (Fed. Cir. Nov. 5, 2012). Nor is there any fact to support any control by Travel Sentry over the manner or timing of the TSA's activities. Indeed, all the relevant facts show just the opposite: That Travel Sentry has no role in or control over how, where and when the TSA performs its actual screening. *See Travel Sentry*, 736 F. Supp. 2d at 638 ("[Tropp's] direct infringement claim against Travel Sentry is only viable if there is sufficient evidence to permit a reasonable jury to infer that Travel Sentry directs and controls the TSA's performance of the additional steps of the method. The record provides no such basis."); *see also Travel Sentry*, 497 Fed Appx. at 966 ("it is clear from the MOU that Travel Sentry neither controls nor directs TSA's performance of steps 3 and 4 of the asserted claims."). Thus, while Travel Sentry does provide some initial instructions to TSA screeners on how to operate the master keys and provides the master keys for use by TSA, this activity, at most, constitutes mere guidance to TSA, but TSA nevertheless acts independently and on its own in connection with the manner and timing of its screening. *Cf. Akamai*, 2015 U.S. App. LEXIS 14175 at *11 ("In sum, Limelight's customers do not merely take Limelight's guidance and act independently on their own. Rather, Limelight establishes the manner and timing of its customers' performance so that customers can only avail themselves of the service upon their performance of the method steps.").

For these reasons, there simply is no basis for Tropp to rely on *Akamai* to support his infringement claims, and any summary judgment motion by Tropp on infringement, based on *Akamai*, would be frivolous. We therefore request that Tropp's request for a pre-motion conference and leave to file a cross motion for summary judgment be denied.

Thank you for your attention to this matter.

Very truly yours,

/s/William L. Prickett
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